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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/852,119      | 05/06/1997  | MARTIN KELLY JONES   | 507011026           | 6661             |

7590 09/11/2003  
SCOTT A HORSTEMEYER  
THOMAS KAYDEN  
HORSTEMEYER & RISLEY SUITE 1500  
100 GALLERIA PARKWAY N W  
ATLANTA, GA 30339

EXAMINER

LOUIS JACQUES, JACQUES H

| ART UNIT | PAPER NUMBER |
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3661

DATE MAILED: 09/11/2003

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| APPLICATION NO./<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
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| EXAMINER |
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Commissioner for Patents

William A. Cuchlinski, Jr.  
SPE  
Art Unit: 3661


RESPONSE TO REMAND BY THE BOARD OF PATENT APPEALS AND  
INTERFERENCES

The Board of Patent Appeals and Interferences remanded this application to the examiner to determine whether appellant and Ross, the patentee, claim "the same patentable invention" by applying the two-way patentability analysis of Winter v. Fujita and to determine the earliest effective filing date for appellant's presently claimed subject matter.

After applying the two-way patentability analysis of Winter v. Fujita it has been determined that appellant and Ross, the patentee, are not claiming the same patentable invention. Also, it has been determined that the Ross patent was filed less than one year before appellant's earliest effective filing date. Therefore, appellant can swear behind the Ross patent with an appropriate declaration under 37 CFR § 1.131.

The application is being returned to the Board of Patent Appeals and Interferences for their determination of the appeal of finally rejected claims 1-21 and 23-49.

If there are any questions regarding this action, please contact William Cuchlinski (703) 308-3873.

  
WILLIAM A. CUCHLINSKI, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

SEP 25 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* MARTIN KELLY JONES

Appeal No. 2000-0872  
Application No. 08/852,119

ON BRIEF

Before THOMAS, BARRETT, and GROSS, *Administrative Patent Judges*.  
GROSS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1 through 21 and 23 through 49, which are all of the claims pending in this application.

Appellant's invention relates to a method for notifying a user in advance of an impending arrival of a vehicle at a vehicle stop. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for notifying a user in advance of an impending arrival of a vehicle at a vehicle stop, comprising the steps of:

monitoring travel of said vehicle;

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forwarding travel data to a computer associated with said user; and

producing a message at said computer for said user indicative of an impending arrival of said vehicle at said vehicle stop before said vehicle reaches said vehicle stop, based upon said travel data.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

|                |           |   |
|----------------|-----------|---|
| Ross (Ross I)  | 5,444,444 | Aug. 22, 1995<br>(effectively filed May 14, 1993) |
| Ross (Ross II) | 5,648,770 | Jul. 15, 1997<br>(effectively filed May 14, 1993) |

Claims 1 through 21, 23 through 35, 37 through 41, 43 through 47, and 49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ross I or Ross II.

Claims 36, 42, and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ross I or alternatively Ross II.

Reference is made to the Examiner's Answer (Paper No. 30, mailed October 29, 1999) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 29, filed September 27, 1999) and Reply Brief (Paper No. 31, filed December 6, 1999) for appellant's arguments thereagainst.

#### **OPINION**

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by

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appellant and the examiner. As a consequence of our review, we will reverse the anticipation rejections of claims 1 through 21, 23 through 35, 37 through 41, 43 through 47, and 49, and the obviousness rejections of claims 36, 42, and 48.

Appellant relies on affidavits under 37 C.F.R. § 1.131 and 1.132 to overcoming the rejections under 35 U.S.C. §§ 102 and 103. In a Remand to the examiner dated March 26, 2001 (Paper No. 33), we asked the examiner to determine whether or not appellant and Ross, the patentee of both patents used in the rejections, are claiming the same patentable invention, as defined in 37 C.F.R. § 1.601(n). The examiner complied, stating in the Response to Remand dated September 11, 2003 (Paper No. 40) that appellant and Ross are not claiming the same patentable invention. Thus, no interference exists. Further, the examiner determined that the patents were filed less than one year prior to the earliest date to which the claimed subject matter is entitled. Accordingly, there is no bar under 35 U.S.C. § 102(b). The examiner admitted, therefore, that appellant can swear back of the patents **via** an affidavit under 37 C.F.R. § 1.131.

Appellant filed a Rule 131 Affidavit on July 19, 1999. The examiner (Answer, page 14) recognizes that 37 C.F.R. § 1.131 requires that "[o]riginal exhibits of drawings or records, or

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photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained," but contends (Answer, page 15) that appellant has failed the requisite evidence. We disagree.

Appellant's affidavit asserts conception prior to May 14, 1993, the effective filing date of the Ross patents, followed by due diligence to May 18, 1993, the filing date of the application. Appellant supplies, as Exhibit B, a declaration from Mr. Horstemeyer, his attorney, explaining the work done and the dates thereof for preparing the patent application. Exhibit C is a **record** of Mr. Horstemeyer's billing for the work done for appellant. The billing record indicates that revisions were made May 5th, 7th, 10th, and 11th of 1993. Exhibit D, a letter from Mr. Horstemeyer to appellant, states that the final draft of the application was mailed to appellant for signature on May 12, 1993. The billing records show no further amendments after May 12, 1993, thereby establishing conception prior to May 14, 1993. Mr. Horstemeyer indicates in the Declaration that May 15th and 16th were a Saturday and Sunday, respectively. The records show that he billed for reviewing the formality documents and formal drawings of the application on May 17, 1993, and then he filed the application on May 18, 1993. We find these records to

be sufficient evidence of conception prior to May 14, 1993 and due diligence up to the filing of the application on May 18, 1993. Accordingly, we must reverse the rejections under 35 U.S.C. §§ 102(e) and 103, as the Ross patents no longer qualify as prior art against appellant.

The decision of the examiner rejecting claims 1 through 21, 23 through 35, 37 through 41, 43 through 47, and 49 under 35 U.S.C. § 102(e) and claims 36, 42, and 48 under 35 U.S.C. § 103 is reversed.

BOARD OF PATENT  
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INTERFERENCES

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